

Application Serial No. 09/740,568
Reply to Office Action of Aug 24, 2005

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Remarks

Claims 1-5, 7-9, 13-14, 17-19, 21-22, 24-25, 27-29, 31-33, 35, 37, 42-43, 46-48, 50-51, 52, 64-70, 71-75, 76-78, 79-83, and 84 stand rejected under 35 USC 101. Claims 52, 79-83 also stand rejected under 35 USC 112 second paragraph. Claims 55-61 are objected to but are indicated as being allowable.

By this amendment, claims 1, 22, 48, 52, 54, 71, 76, 83 and 84 have been amended, claims 72, 73, 75, and 80 have been cancelled, and new claims 85-89 have been added. The Commissioner is authorized to charge Deposit Account #502997 the required fee for the newly added independent claim 89.

The Examiner's rejection's are addressed and traversed below, and reconsideration is respectfully requested. With this amendment, including the remarks and discussion herein, Applicant believes the application is in condition for allowance

Rejections Under 35 101

Claims 1-5, 7-9, 13-14, 17-19, 21-22, 24-35, 27-29, 31-33, 35, 37-38, 42-43, 46-48, 50-51, 64-70, and 76-78 have been rejected under 35 USC 101 as not being directed to statutory subject matter, specifically because they are not "within the technological arts". The rejections are respectfully traversed. Applicant notes with appreciation Examiner's suggestions for overcoming the rejections.

Claim 1 has been amended to specifically recite an electronic asset registry and to include the use one or more microprocessor or computer devices in the managing of read and write privileges. The claimed process clearly applies, involves or uses the technological arts and thus is clearly statutory. Claims 2-5, 7-9, 13-14, 17-19, 21-22, 24-35, 27-29, 31-33, 35, 37-38, 42-43, 46-48, 50-51, 64-70, and 76-78 depend either directly or indirectly from claim 1 and thus also involve, use and apply the technological arts and are therefore statutory under 35 USC 101. Applicant believes that said claims are allowable.

Notwithstanding the amendment of claim 1, Applicant respectfully submits that the rejections of the method claims based on their not falling within the technological arts are improper and should be withdrawn.

35 U.S.C. § 101 reads:

Application Serial No. 09/740,568
Reply to Office Action of Aug 24, 2005

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Process is defined in 35 USC 100(b) to encompass: *[a] process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.* The claimed invention is clearly a new and useful process as discussed in the specification and in the earlier response.

The Federal Circuit has held that new and useful processes are statutory irrespective of their technology (*State Street Bank and Trust v. Signature Financial Group*, 148 F.3d 1368 (Fed. Cir. 1998)): In *State Street*, the Federal Circuit stated:

The plain and unambiguous meaning of 35 U.S.C.S. § 101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in 35 U.S.C.S. §§ 102, 103, and 112

...
Congress intends 35 U.S.C.S. § 101 to extend to anything under the sun that is made by man. Thus, it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations

...
The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to —process, machine, manufacture, or composition of matter—but rather on the essential characteristics of the subject matter, in particular, its practical utility

Examiner cites Ex Parte Bowman indicating that the BPAI has affirmed rejections based on lack of technology. Respectfully, the applicant points out that the Bowman decision is non-binding precedent, and subject to review by the Federal Circuit. Moreover the facts and issues of Bowman are sufficiently different from the present case, so as to render the decision and rationale applied by the BPAI moot or at best tangential. Specifically, in the Bowman case, not only did the claims not recite any positive link to any technological art, neither did the specification. It is this lack of technological disclosure anywhere within the specification that results in the BPAI affirming the 101 rejections. The following points are made by the judges in the Bowman opinion:

Application Serial No. 09/740,568
Reply to Office Action of Aug 24, 2005

Express Mail Label:EU48164991IUS

"The examiner responds that the noted guidelines are inapplicable here because appellant has not recited the use of a computer in either the specification or the claims. The examiner finds that neither the specification nor the claims discuss the use of any technology with respect to the claimed invention....

... We agree with the examiner. Appellant has carefully avoided tying the disclosed and claimed invention to an technological art or environment. ... The Examination Guidelines for Computer--Related Inventions are not dispositive of this case because there is absolutely no indication on this record that the invention is connected to a computer in any manner."

... "In the present application, the specification is silent as to the need for any apparatus to carry out the claimed process or to make the ultimate decision regarding the value of the intangible asset."

*... "Here, I find no such application, involvement, use or advancement of the technological arts in the invention as recite in express language of claim 1 or in the disclosed invention with which to interpret the language of claim 1. While [*19] I realize that a computer may arguably not be required to be disclosed In re Dossel, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997) (finding the inferred disclosure of a computer without any express disclosure), appellant has not argued the use of any item or computer with which to practice or apply the claimed process beyond the abstraction of the human mind."*

Thus, the BPAI's holding in Bowman was due to the lack of disclosed technology anywhere in the written record, including the specification. This is not the case in the present application, wherein the specification discloses numerous implementations of the claimed methods and systems involving the technological arts, implementations involving the use or application or involvement of computers or microprocessors or electronic networks or other electronic means, etc. in some way within the claim systems or methods. For instance Figs. 1-10 contain class, case, and activity diagrams represented in the Unified Modeling Language (UML) recognized by those of ordinary skill in the software design and development arts as examples of ways to design and implement aspects of the claimed invention (although the claimed invention is not limited to these examples). Applicant respectfully points out that the following example portions of the specification clearly describe example implementations and embodiments of the claimed invention which utilize processors, networks or computers (although the invention claimed is not limited to these implementations or embodiments):

Page3, lines 7-12, 24-29, page 5 lines 14-20, page 8 lines 3-18, p30-31 lines 29-31, page 32 lines 13-30, page 37 lines 3-20, page 54 lines 10-29, page 60 lines 13-29 .

Application Serial No. 09/740,568
Reply to Office Action of Aug 24, 2005

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Thus, unlike in *Ex parte Bowman*, where the BPAI found no indication in the written record that the claimed invention involved or utilized the technological art, Applicant has shown that in the present application, examples of the use of technology is clearly expressed and enabled, and thus the rationale used by the BPAI in *Bowman* is not applicable and improperly applied to the present application

Applicant respectfully requests withdrawal of the rejections.

35 USC 101 Rejections of Claims 52 and 79-83

Claims 52 and 79-83 have been rejected under 35 USC 101 as being directed to non-statutory subject matter on the basis that the claims embrace and overlap two different statutory classes of invention. Applicant had amended claim 52 to limit it to single statutory class and submits that the claim 52 as amended, and its remaining dependent claims 54, 79, and 81-83, no longer combine two different statutory classes and thus are statutory. The rejections have been overcome, and Applicant respectfully requests withdrawal of these rejections.

35 USC 101 Rejections of Claims 71-75 and 84

Claims 71-75 and 84 have been rejected under 35 USC 101 as being directed to non-statutory subject matter because they are directed to a "*disembodied data structure... without any associated functionality*". Claims 72, 73 and 75 have been cancelled without prejudice. Applicant has amended claims 71 and 84, and added new claim 87, each of which is directed to a data structure which causes, imparts, or directs functionality of one or more processor or computers to the granting of read and write access privileges. Applicant submits that said claims as amended are directed to functional descriptive material and impart or direct the functionality of one or more computer components (e.g., the granting of read and write privileges) and are therefore directed to statutory subject matter (see for instance *In re Lowry*, 32 F.3d at 1580-1581). Applicant respectfully requests withdrawal of these rejections.

Rejections Under 35 112 Second Paragraph

Claims 52 and 79-83 have been rejected under 35 USC 112 second paragraph for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the

Application Serial No. 09/740,568
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invention, on the basis that they are not sufficiently precise due to the combining of two different statutory classes. Applicant had amended claim 52 to limit it to single statutory class and submits that the claim 52 as amended, and its remaining dependent claims 54, 79, and 81-83, no longer combine two different statutory classes and thus are not indefinite. The rejections have been overcome, and Applicant respectfully requests withdrawal of these rejections.

Claims 52 and 79-83 have also been rejected under 35 USC 112 second paragraph for lack of antecedent basis. Examiner states that "*claims 52, 79, 81, and 83 recite the phrase "the plurality of entities" which lacks positive antecedent basis*". Applicant disagrees and respectfully points out that independent claim 52, as previously amended, recites "managing read and write privileges to a plurality of entities...". Therefore the subsequent recitation of the phrase "the plurality of entities" in claims 52, 79, 81, and 83 clearly does have antecedent basis and thus the claims are not indefinite. The rejections have been overcome, and Applicant respectfully requests withdrawal of these rejections.

Allowable Subject Matter

Examiner objects to claims 55-61 as being dependent upon a rejected base claim, but states the claims would be allowable if rewritten in independent form. Applicant notes that claim 55 is already in independent form, claims 56-61 depending therefrom. Examiner has confirmed in a telephonic conversation with Applicant that the objection was inadvertent and that the claims 55-61 are allowable as written. Applicant acknowledges the notice of allowability of claims 55-61.

Conclusion

For all the reasons discussed above, Applicant believes that all rejections have been overcome and submits that the application is in condition for allowance and requests a timely Notice of Allowance be issued.

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